

REMARKS

This application provides for herbicidal compositions comprising at least one herbicidally active surfactant, at least one non-silicone surfactant and at least one humectant. Applicants discovered that the inventive compositions exhibit superior herbicidal activity, which may be synergistic in nature (see paragraph bridging pages 24 and 25).

Applicants would like to bring to the attention of the Examiner copending application USSN 09/911,032, which specifies silicone surfactants. USSN 09/911,032 is presently assigned to the same Examiner as this application.

Pursuant to 37 C.F.R. 1.136(a) Applicants petition the Assistant Commissioner to extend the time period to file a response to the outstanding Office Action by one (1) month, *i.e.*, up to and including April 20, 2003. A check for \$110.00 is enclosed to cover the cost of this petition. It is believed that no further fee is required for the consideration of this paper. If, however, a fee is required, the Assistant Commissioner is authorized to charge such fee to Deposit Account No. 50-0320.

Claims 1 to 4, 12 to 19, 21 to 26, and 28 to 30 stand rejected under 35 USC 103(a) as being allegedly unpatentable over the combined teachings of Griffin et al. US 4,444,917 ("Griffin"), Zeneca PCT WO 96/00010, and Matsumoto et al. (in Chapter 25 of *Adjuvants for Agrochemicals*, Chester Foy, ed., pp. 261-271, 1992; "Matsumoto"). Applicants respectfully disagree and urge the removal of this rejection as none of these publications taken in any fair combination suggests that the particular combination of active agents, non-silicone surfactants and humectants would provide herbicidal combinations that exhibit outstanding herbicidal activity, especially under dry conditions. Moreover, even if it were held that the reject

establishes a *prima facie* case of obviousness, the Declaration of Dr. Bickers clearly overcomes this finding.

In order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the teaching in the reference. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). As stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992); “the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants’ disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Against this background, none of the cited documents, either alone or in combination, teaches, suggests or discloses the instantly claimed invention. The Office Action (at 2) notes that Griffin teaches that sulfonylurea herbicides “may be combined with various surface active agents (column 6), as well as other adjuvants such as humectants (col 7, line 1) for herbicidal activity against various weeds, including *Bromus tectorum*.” Griffen, however, teaches the use of surfactants to improve the solubility of herbicides in liquid formulations, not to enhance herbicidal activity. Griffen, moreover, does not disclose specific humectants. The Office Action (at 2 and 3) notes that Zeneca teaches combinations of glyphosate with secondary herbicides and other additives such as “various surfactants...and humectants.” Zeneca teaches that the activity of the glyphosate combination “may generally be enhanced by the incorporation

of a humectant," and discloses several humectants (page 7). Zeneca, however, does not disclose experimental examples with specific humectants. Moreover, although Zeneca teaches glyphosate combinations containing surfactants and discloses experimental examples with specific surfactants, the use of surfactants is taught not for enhancing herbicidal activity, but for "improved rainfastness" (page 2) and "compatibility and stability of concentrated compositions" (page 9). Matsumoto does not teach the use of surfactants in herbicidal compositions. Moreover, although the Office Action (at 3) notes that Matsumoto teaches that "the addition of humectants to pesticidal...compositions generally enhances the uptake of active agents," Matsumoto also teaches against the applicants' invention by disclosing that sodium lactate does not enhance herbicidal activity. Matsumoto also teaches that herbicidal activity can be adversely affected because of problems of solubility associated with the addition of some humectants (page 269).

Griffen, Zeneca, and Matsumoto, therefore, provide no suggestion, individually or in combination, to the practitioner that the addition of specific surfactants and humectants would produce compositions that exhibit superior herbicidal activity. In light of the uncertainty of humectant effects taught in Matsumoto, it would be in the absence of more guidance merely obvious, to try to combine the humectants and surfactants of these references. As obvious to try is not the standard under 35 USC 103(a), the rejection does not establish a *prima facie* case of obviousness. Even if it was so held that a person with ordinary skill in the art would have been motivated to practice the instant invention from a reading of the cited art, a point Applicants do not concede, the skilled artisan would not expect the superior herbicidal activity of the invention.

To provide additional examples of the superior herbicidal activity of the invention, submitted herewith is the Declaration under 37 C.F.R. §1.132 of Dr. Udo Bickers, a

co-inventor of the instant invention. In further support of Applicant's position that the present claims are patentable over the prior publication relied upon in the rejection, Applicants present the Declaration of Dr. Bickers. In the Declaration, Dr. Bickers presents additional experiments wherein *Bromus tectorum* was exposed to herbicidal compositions containing citric acid, succinic acid, and malic acid as in Example B.3 (page 45). As was the case for sodium lactate and propylene glycol (Table 3, page 46), these three additional humectants enhanced herbicidal activity. Hence, the data provide further evidence to support Applicant's position that the inventive composition exhibit superior herbicidal activity, activity which is not suggested by the prior publications relied upon in the rejection.

In view of the foregoing, it is urged that the present invention is patentable over the combined teachings of Griffen, Zeneca, and Matsumoto, and reconsideration and withdrawal of this rejection are respectfully requested.

Favorable action is earnestly solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By:


Mark W. Russell
Registration No. 37,541
745 Fifth Avenue
New York, New York 10151